

### **DETAILED ACTION**

1. This office action is responsive to the amendment filed 02/03/2010. Claims 1-3, 5-10, and 12-20 are pending.

#### ***Claim Rejections - 35 USC § 112***

Claims 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if "the opening" in line 3 of claims 18, 19, and 20 is the same opening of claims 1, 5, and 6. If the recited "opening" in claims 18-20 is the same opening, it is unclear how the rectangular shape is formed by the edge of the covering portion, the elongated piece, and the fixing portion since the opening of claims 1, 5, and 6 is formed in the first grasping plate. For examination purposes, claims 18-20 have been treated as reciting a rectangular opening different from the opening of claims 1, 5, and 6. It is noted that if the opening of claims 18-20 is indeed a different opening, there is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

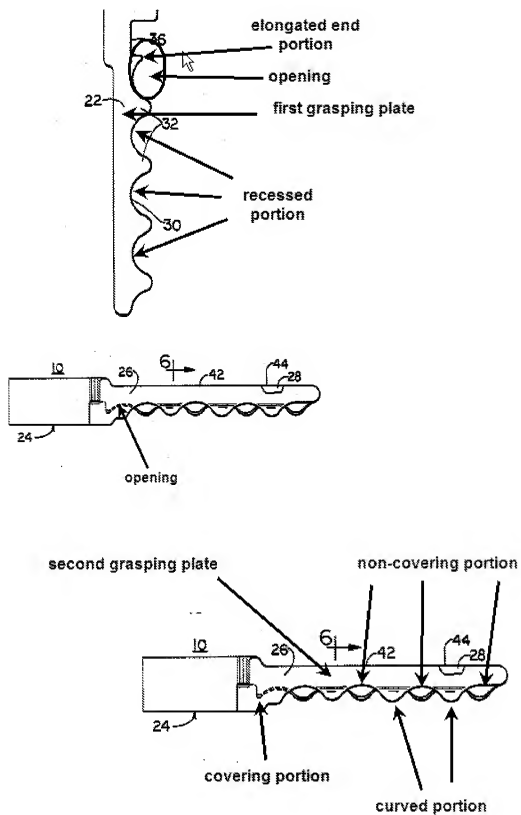
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1, 5, and 6-10, as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Kees, Jr. et al. (US 4,340,061).

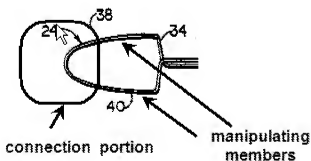
Regarding claims 1 and 6, Kees, Jr. et al. disclose a surgical holder comprising a grasping member (20, 22) for grasping a tissue, a manipulation member (24) for manipulating the grasping member (20, 22), and a connection portion (see figure below) with one end

connected to the manipulation member, wherein: the grasping member includes a first grasping plate (22), and a second grasping plate (20) provided so as to oppose the first grasping plate in a movable manner so that they are able to become closer to each other or more distanced from each other; the first grasping plate includes a retaining portion having an opening (see figure below) of a U- shape or substantially a U-shape which is opened toward an outer side of the first grasping plate and a supporting portion having a recessed portion (rounded scallops 30 of first grasping plate 22; see figure below), the opening being provided in one end of the first grasping plate and the recessed portion being provided in the other end of the first grasping plate, the first grasping plate includes an edge portion which defines the shape of the opening, the end portion (see figure below) of the edge portion being capable of being inserted into a tube of tubular tissue, the second grasping plate includes a covering portion (see figure below) formed so as to cover an entire surface or a part of the opening of the first grasping plate, a non-covering portion (rounded scallops 30 of second grasping plate 20; see figure labeled below) which does not cover the first grasping plate, and a fixing portion having a curved portion (see figure below), the covering portion being provided in one end of the second grasping plate and the curved portion being provided in the other end of the second grasping plate, the curved portion opposing the recessed portion to form the tissue grasping space when the first grasping plate and the second grasping plate are positioned so as to oppose on another (Fig. 1), a first grasping portion which can grasp a part of a tissue between the opening of first grasping plate and the covering portion of the second grasping plate is provided in one end portion of the grasping member, and the opening exposing another part of the tissue when the part of the tissue is grasped by the first grasping portion; and a second grasping portion which can form a tissue grasping space between the recessed portion of the first grasping plate and the curved portion of the second grasping plate provided in another end portion of the grasping member.

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Regarding claim 5, Kees, Jr. et al. disclose surgical holder comprising a grasping member (20,22) for grasping a tissue, a manipulation member (see figure below) for manipulating the grasping member, and a connection portion (see figure below) with one end connected to the manipulation member and the other end provided with a fixing tool (clip handling tool, col. 2, ln. 26-28), wherein: the grasping member includes a first grasping plate (22), and a second grasping plate (20) provided so as to oppose the first grasping plate in a movable manner so that they are able to become closer to each other or more distanced from each other; the grasping member is formed into a rectangular shape with the manipulation member elongated from a side thereof (Fig. 3-4); a first grasping portion which can grasp a part of a tissue between the first grasping plate and the second grasping plate, and an opening (see figure above), provided in the vicinity of the first grasping portion and exposing another part of the tissue, is provided in one end portion of the grasping member, the opening being opened at an outer side of the first grasping portion; the first grasping plate includes an edge portion which defines the shape of the opening, the end portion of the edge portion being capable of being inserted into a tube of tubular tissue, and a second grasping portion which can form a tissue grasping space between the first grasping plate and the second grasping plate (between curved and recessed portions labeled above) provided in another end portion of the grasping member, the tissue grasping space and the opening being positioned at respective ends on one axis of the grasping member.



Regarding claim 7, the device of Kees, Jr. et al. is capable of grasping a tubular tissue with a surrounding tissue, and the part which defines the shape of the opening of the first grasping plate and the covering portion of the second grasping plate is capable of grasping the surrounding tissue.

Regarding claim 8, the device of Kees, Jr. et al. is capable of grasping a tubular tissue, and a tissue grasping space formed by the recessed portion of the first grasping plate and the curved portion of the second grasping plate is capable of grasping the tubular tissue.

Regarding claim 9, the device of Kees, Jr. et al. is capable of grasping a tubular tissue, and the retaining portion of the first grasping plate and the covering portion of the second grasping plate is capable of grasping the tubular tissue at one point of the tubular tissue and a tissue grasping space formed by the recessed portion of the first grasping plate and the curved portion of the second grasping plate is capable of grasping another point of the tubular tissue.

Regarding claim 10, the device of Kees, Jr. et al. is capable of grasping a tubular tissue by inserting the edge portion into a tube of the tubular tissue.

Regarding claims 12-14, Kees, Jr. et al. disclose the recessed portion is provided toward a thickness of the first grasping plate.

Regarding claims 15-17, Kees, Jr. et al. disclose the end portion of the edge portion is elongated.

Regarding claims 18-20, Kees, Jr. et al. disclose the first and second grasping plates of flat plate shape (Figure 3), the curved portion is provided on a fixing portion which is provided to extend from the covering portion through an elongated piece (see figure above), and the opening of a rectangular shape is formed by an edge (34) of the covering portion, the elongated piece, and the fixing portion (Fig. 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kees, Jr. et al. (US 4,340,061) in view of Mandel et al. (US 2002/0177863).

Regarding claim claims 2 and 3, Kees, Jr. et al. fail to disclose a tissue protection material is attached to an opposing surface of the first grasping plate and/or the second grasping plate, wherein the tissue protection material is permeated with medicines. Mandel et al. disclose providing an antimicrobial and/or antibiotic coating to the surfaces of a ligating clip in order to prevent and kill microorganisms in the area of the clip (paragraphs 33 and 34). It would have been obvious to one of ordinary skill in the art to modify the clip of Kees, Jr. et al to include a tissue protecting coating containing antibiotic or anti-microbial materials or medicines in order to prevent growth and to kill microorganisms in the area of the clip.

***Response to Arguments***

6. Applicant's arguments filed 02/03/2010 have been fully considered but they are not persuasive. Applicant argues that Kees, Jr. et al. fail to disclose the first grasping plate includes an edge portion which defines a shape of the opening, the end portion of the edge portion being inserted into a tube of the tubular tissue. The Examiner respectfully disagrees. Kees, Jr. et al. disclose the first grasping plate has an edge portion which defines a shape of the opening, wherein the end of the edge portion (labeled as elongated end portion in the figure provided above) is *capable* of being inserted into a tubular tissue. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

#### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JENNIFER L. HORNBERGER whose telephone number is (571)270-

3642. The examiner can normally be reached on Monday through Friday from 8am-5pm, Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on (571)272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jlh  
04/08/2010

/Todd E Manahan/  
Supervisory Patent Examiner, Art Unit 3734